

REMARKS / ARGUMENTS

I. General Remarks and Disposition of the Claims

Please consider the application in view of the following remarks. Applicants thank the Examiner for his careful consideration of this application, including the references that Applicants have submitted in this application and, pursuant to Manual of Patent Examining Procedure § 609.02, all references submitted in the patent applications to which this application claims priority under 35 U.S.C. § 120.

At the time of the Office Action, claims 77-79, 81-87, 107-112, 187, 188, 190-196 and 198-220 were pending in this application. Claims 77-79, 81-87, 107-112, 187, 188, 190-196 and 198-220 are subject to an election requirement. Applicants respectfully request reconsideration in light of the remarks contained herein.

II. Remarks Regarding Election Requirement

In the Office Action, the Examiner has required a species election under 35 U.S.C. § 121. With respect to this election requirement, the Examiner stated:

3. Claims 77-79, 82, 107-112, 187, 188, 198-203, 206-209 and 215-220 are respectively generic to the following disclosed patentably distinct species for the method of acidizing in a subterranean formation comprising providing a permeability-modifying treatment fluid modifier that includes a modifier that comprises a hydrophobically-modified water soluble polymer:

a. the hydrophobically-modified water soluble polymer having a molecular weight in the range of about 100,000 to 10,000,000 that is formed from the reaction of a hydrophobic compound and a hydrophilic polymer (as recited in claims 77, 83, 187, 192, 206 and 210);

b. the hydrophobically-modified water soluble polymer having a molecular weight in the range of about 250,000 to 3,000,000 that is formed from a polymerization reaction that comprises a hydrophilic monomer and a hydrophobically-modified hydrophilic monomer (as recited in claims 77 and 187).

4. These species are independent or distinct because as disclosed they have mutually exclusive characteristics for each identified species. In addition, these species are not obvious variants of each other based on the current record.

5. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims

shall be restricted if no generic claim is finally held to be allowable. That is, Applicant must elect **one** species for examination from a) or b) as listed above in paragraph #3.

6. In addition, **if Applicant elects species a)** [i.e., the hydrophobically-modified water soluble polymer having the specified molecular weight that is formed from the reaction of a hydrophobic compound and a hydrophilic polymer], **a further election of species is required for each of the following components:**

- c. For the hydrophobic compound component:
 - i. Alkyl halide (claims 86, 195 and 213);
 - ii. Sulfonate (claims 86, 195 and 213);
 - iii. Sulfate (claims 86, 195 and 213);
 - iv. Organic Acid Derivative (claims 86, 87, 195, 196, 213 and 214).
- d. For the hydrophilic polymer component:
 - i. Cellulose (claims 84, 193 and 211);
 - ii. Polyamide (claims 84, 193 and 211);
 - iii. Polyetheramine (claims 84, 193 and 211);
 - iv. Polyhydroxyetheramine (claims 84, 193 and 211);
 - v. Polysulfone (claims 84, 193 and 211);
 - vi. Starch (claims 84, 85, 193, 194, 211 and 212).

7. However, **if Applicant instead elects species b)** [i.e., the hydrophobically-modified water soluble polymer having the specified molecular weight that is formed from a polymerization reaction that comprises a hydrophilic monomer and a hydrophobically-modified hydrophilic monomer], **a further election of species is required from each of the following:**

- e. For the hydrophilic monomer:
 - vii. One species such as those listed in paragraph [0031] on page 10 of the specification; and
- f. For the hydrophobically-modified hydrophilic monomer:
 - viii. One species from the specification. [It is unclear to Examiner as to where there is written description support in the present specification for this particular component of species b).]

8. There is search burden for examination of these species [c) to f)] because they are drawn to various distinct classes of compounds requiring a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries). Moreover, the prior art applicable to one species may not likely be applicable to another species; and/or the species

are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

9. Applicant is advised that the reply to this requirement to be complete must include (i) an election to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species, including any claims subsequently added. That is, **Applicant must elect one species from a) or b)** as listed above in paragraph #3. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

10. Furthermore, **if Applicant elects a)** from the species listed above in paragraph #3, **Applicant must further elect one species for each of c) and d)** from those listed in paragraph #6 above.

11. However, **if Applicant instead elects b)** from the species listed above in paragraph #3, **Applicant must further elect one species for each of e) and f)** from those listed in paragraph #7 above.

12. The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should Applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

13. Upon the allowance of a generic claim, Applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

(Office Action at 2-6.) Applicants understand that the Examiner has required Applicants to elect one species of a relative permeability modifier. Accordingly, Applicants elect "a reaction comprising a hydrophilic polymer and a hydrophobic compound, wherein the hydrophobically

modified water-soluble polymer formed from the reaction has a molecular weight in the range of about 100,000 to about 10,000,000.” Furthermore, Applicants understand that the Examiner has required Applicants to elect one species of a hydrophobic compound and one species of a hydrophilic polymer. Accordingly, Applicants elect an organic acid derivative as the hydrophobic compound and starch as the hydrophilic polymer. In accordance with the election requirement, Applicants identify claims 77-79, 81-87, 107-112, 187, 188, 190-196 and 198-220 as falling within these elected species. Applicants reserve their right to take up prosecution of the non-elected species if a linking or generic claim is allowed.

III. No Waiver

All of Applicants’ arguments and amendments are without prejudice or disclaimer. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner’s additional statements.

SUMMARY

In light of the above amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants believe that no fees are due with the filing of this response. Should the Commissioner deem that any other fees are due, Applicants respectfully request that the Commissioner accept this as a Petition Therefor, and direct that any additional fees be charged to Baker Botts, L.L.P.’s Deposit Account No. 02-0383, Order Number 063718.0321.

Respectfully submitted,

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